

REMARKS

Claims 1-37 are pending in the present application. The Examiner has rejected claims 1-37.

I. REJECTION OF CLAIMS 1-15, 17 AND 19-37 UNDER 35 U.S.C. § 103(a)

Claims 1-15, 17 and 19-37 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,006,112 ("Rucki") in view of U.S. Patent No. 4,055,807 ("Priniski") and U.S. Patent No. 5,054,114 ("Erickson"). Applicants respectfully traverse the rejection.

A. Teaching Away: Improper Reference Combination

M.P.E.P. § 2145(X)(D)(2) clearly states that "[i]t is improper to combine references where the references teach away from their combination." Applicants respectfully submit that Rucki, Priniski and Erickson were improperly combined.

B. Erickson and Priniski

For example, Erickson and Priniski were improperly combined because they teach away from each other. Erickson teaches a broadband PIN diode transmit/receive switch as illustrated in the sole figure of Erickson. See, e.g., Erickson at Abstract. At col. 1, lines 9-14, Erickson states that

RF isolation switches using single pole double throw PIN diode switches provide a convenient way for coupling a common signal path to one of a plurality of circuit paths. PIN diode switches being completely electronic are superior in speed and reliability to mechanical relays for such a purpose.

Thus, Erickson teaches that completely electronic switches such as, for example, PIN diode switches SW1, SW2 are superior in speed and reliability to mechanical relays for coupling either a transmitter 12 or a receiver 14 to an antenna 10. See, e.g., Erickson at the sole figure.

On the other hand, Priniski entirely teaches away from using a completely electronic switch for coupling either a transmitter 62 or a receiver 44 to an antenna 12. In fact, Priniski teaches using a "manually operable switch 60" which is preferably a "push-to-talk switch normally found in combination with a hand-held microphone". See, e.g., Priniski at col. 2, lines 40-45. Thus, Priniski teaches using a manual, mechanical switch 60 to switch the antenna 12 between the transmitter 62 and the receiver 44.

Priniski further teaches away from Erickson by explicitly teaching away from the use of PIN diode switching schemes. At col. 1, lines 22-29, Priniski teaches away from using "PIN diodes in a biasing scheme whereby the diodes either connect or disconnect the receiver or transmitter to the antenna" (e.g., Priniski at col. 1, lines 22-25) because "PIN diode switching schemes" are "expensive" and "generally complex to implement" (e.g., Priniski at col. 1, lines 26-29).

Thus, Priniski teaches away from Erickson, thereby teaching away from the combination of Priniski with Erickson. See, e.g., M.P.E.P. § 2145(X)(D)(2). Accordingly, Priniski cannot be properly combined with Erickson.

Since Priniski cannot be properly combined with Erickson, the Examiner cannot maintain an obviousness rejection of claims 1-15, 17 and 19-37 based on the combination of Rucki, Priniski and Erickson.

C. Conclusion

For at least the above reasons, Applicants respectfully submit that, since Priniski was improperly combined with Erickson, the Examiner cannot maintain a rejection based on the combination of Rucki, Priniski and Erickson. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 1-15, 17 and 19-37.

II. REJECTION OF CLAIMS 16 AND 18 UNDER 35 U.S.C. § 103(a)

The Office Action states that "[c]laims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rucki et al. (US Patent No 6006112) in view of Priniski et al. (US Patent No 4055807) and Burgess (US Patent No 6459885 B1) as applied to claims 1-15 above, and further in view of Lampen (US Patent No 5375257)." Office Action at page 9, section 3 (emphasis added).

However, this statement is inconsistent with the patent documents cited and the arguments presented by the Examiner with respect to claims 1-15. As set forth in the Office Action, claims 1-15 were rejected as obvious over Rucki in view of Priniski and Erickson (not Burgess). Furthermore, Burgess is not used in any arguments presented by the Examiner. Accordingly, Applicants will assume that the Examiner intended to cite Erickson instead of Burgess.

A further inconsistency in the Office Action states that *merely* "Rucki and Priniski disclose everything except the features of a transmitter that is enabled comprising shifting a first signal on one of the differential lines by 90 degrees, shifting a second signal on a second one of the differential lines by 90 degrees in an opposite direction, and combining the shifted first and second signals." However, as previously set forth in the Office Action, Rucki, Priniski and Erickson were combined to support an obviousness rejection of claims 1-15 including the base and intermediary claims (i.e., claims 13 and 15) from which the claims at issue (i.e., claims 16 and 18) depend. Accordingly, Applicants will assume that the Examiner intended to cite the combination of Rucki, Priniski and Erickson instead of the mere combination of Rucki and Priniski.

Thus, Applicants respectfully submit that claims 16 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over Rucki in view of Priniski, Erickson and U.S. Patent No. 5,375,257 ("Lampen"). Applicants respectfully traverse the rejection.

For at least the above-stated reasons, since Priniski cannot be properly combined with Erickson, the Examiner cannot maintain an obviousness rejection of claims 13 and 15 based on the combination of Rucki, Priniski, Erickson and Lampen. Since the rejection of claims 13 and 15 cannot be maintained, it is respectfully requested that the rejection be withdrawn with respect to claims 16 and 18, which depend from claims 13 and 15.

III. PRIMA FACIE OBVIOUSNESS

Applicants respectfully submit that, for at least the above reasons, the Examiner has not met the burden of proof necessary to maintain a *prima facie* case of obviousness. M.P.E.P. § 2142 states that

[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Furthermore, Applicants respectfully request that the Examiner discuss each and every element as set forth in the claims to maintain a *prima facie* case of obviousness. For example, claims 4-12, 15-19 and 23-31, either through recitation or dependence, comprise one or more of the following elements:

a differential line,

differential lines,
a differential transistor pair, and
a second differential transistor pair.

However, the Examiner has failed to point out these elements with particularity with respect to the documents cited in the Office Action.

It is therefore respectfully requested that, in a subsequent Office Action, if necessary, the Examiner point out, with particularity, a differential line, differential lines, a differential transistor pair and a second differential pair with respect to the documents cited by the Examiner in order to support a *prima facie* case of obviousness.


IV. CONCLUSION

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-37 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

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Respectfully submitted,


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